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IN THE  
**SUPREME COURT OF THE UNITED STATES**

OCTOBER TERM, 1943

No.

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RICHARD W. WERNER,

*Petitioner,*

*vs.*

HEIN-WERNER MOTOR PARTS CORP.,  
a Wisconsin Corporation,

*Defendant-Appellee-Respondent.*

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PETITION OF RICHARD W. WERNER FOR A  
WRIT OF CERTIORARI TO THE CIRCUIT  
COURT OF APPEALS FOR THE  
SEVENTH CIRCUIT  
AND  
SUPPORTING BRIEF

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*To the Honorable, the Chief Justice of the United States  
and Associate Justices of the Supreme Court of the  
United States:*

Your Petitioner, Richard W. Werner, respectfully prays for a writ of certiorari to the Circuit Court of Appeals for the Seventh Circuit, to review the judgment of that court entered on the 30th day of April, 1943. A transcript of the record, including the proceedings in said Circuit Court of Appeals, is furnished herewith.

## SUMMARY STATEMENT OF MATTER INVOLVED

1. This is a patent suit, in which the only issue is a matter of claim interpretation.

2. Claim 6 of Petitioner's patent No. 2,038,974 upon a hydraulic jack is the only claim in suit. Its validity, while placed in issue, has not been seriously challenged. The claim reads as follows:

6. A hydraulic jack comprising the combination with an upright cylinder and a concentric reservoir, of a base with which said cylinder and reservoir are in liquid tight relation, a ram operative in said cylinder, a duct in said base leading directly from the bottom of said cylinder to an exterior side surface of the base and provided at an intermediate point with a valve seat shoulder, a bleed valve threaded in said duct for axial adjustment therein to and from said shoulder, a pump chamber formed in said base and opening therefrom along an axis inclined with reference to said cylinder and intermediate said cylinder and said duct, a bypass duct leading from said first mentioned duct externally of said shoulder to said reservoir, a pump plunger operative in said chamber, a high pressure duct extending from the chamber to the first mentioned duct, and a supply duct in communication with the reservoir and leading to the high pressure duct, and check valves at the junction of the supply duct with the high pressure duct whereby to control liquid urged by the plunger from said reservoir to the cylinder.

3. Claim 6 is applicable verbatim to Respondent's accused jack. The District Court (E.D. Wis.) and Seventh Circuit Court of Appeals held claim 6 not to be infringed on the basis of an interpretation of the claim which involves the reading into the claim of a limita-

tion not expressed therein. The opinion below (Tr. 273) is published 57 Pat. Q. 268; 135 Fed. (2d) 187.

4. A major feature of the jack of the patent is the oblique angular position of the pump chamber, whereby it is intermediate the vertical ram cylinder and the almost horizontal release duct. (For a more complete description of the structure, see the appended brief.)

5. In the combination set forth in claim 6, the position of the pump intermediate the ram cylinder and the release duct, first, reduces leakage (by making possible a reduction in the number of plugs exposed to high pressure) and, secondly, permits the ram cylinder to be centered on the jack base (to avoid tipping) without reducing the possible ram extension. (In the prior art the ram cylinder either had to be nearer the end of the base or some of the ducts had to be located beneath the ram cylinder, thereby reducing the length and possible lift of the ram because the overall height of the collapsed jack is limited by the height of the vehicle axles beneath which it is used.)

6. Respondent's accused jack was designed before issue of Petitioners' patent with full knowledge of Petitioner's invention, which had been disclosed to Respondent by Petitioner in connection with the offer of a license. (Tr. 18)

7. Respondent's accused jack uses the intermediately located pump chamber of the patent in suit (1) to bring the ram cylinder toward the center of the base without increasing the height of the jack and (2) to reduce the number of external plugs subject to high pressure. The accused jack contains a single high pressure plug, whereas Respondent's previous jacks had from three to seven high pressure plugs.

8. Respondent's contention of non-infringement is based on a slight and colorable evasion. Its pump chamber, while disposed at an oblique angle between the ram cylinder and the relief duct, is slightly offset laterally from the plane in which the ram cylinder and release duct are located. Respondent points to the fact that the slight lateral offset of the pump chamber requires Respondent to use in the accused jack a cross bore closed by one high pressure plug, thus imperfectly realizing the advantages of the patent. However, the claim in suit does not mention plugs. Reduction in the number of plugs is not the invention, but is an *advantage* of the invention. Respondent has reduced the number of plugs and has thus achieved this advantage in substantial measure, though not to the fullest extent suggested by the patent.

9. Despite the fact that the pump chamber of Respondent's jack is geographically and functionally intermediate the ram cylinder and the release duct, in the sense in which the term "intermediate" is normally used, and despite the fact that Respondent's jack thereby achieves most of the objectives of the patent in suit, and despite the fact that claim 6 in suit does not require the pump chamber to be co-planar with the ram cylinder and the relief duct, the courts below nevertheless found the accused jack to escape infringement in the particular noted.

10. The art of record does not disclose any intermediate location of a pump chamber, or any structure comparable to that claimed, or any inclined pump chamber in the angle between the ram cylinder and the release duct in the same plane or otherwise. Consequently there is nothing in the art to require the claim in suit to be given the interpretation assigned to it by the Court below.

11. During pendency of the application for the patent in suit, claims referring to the location of the ducts in a single plane were considered. (Tr. 119) Absence of any such limitation from claim 6 in suit, therefore, indicates intent on the part of the Commissioner of Patents not to qualify the allowed claim in this respect.

12. The invention in controversy has been extensively recognized by the industry:

(a) One large manufacturer (American Grinder and Specialty Co.) holds a license under the patent in suit (Plaintiff's Exhibit 13).

(b) Two large jack manufacturers, strangers to this litigation, copied Plaintiff's construction when it first appeared on the market prior to the issue of the patent in suit, and, when charged with infringement, changed their constructions in recognition of the patent. (Tr. 25-27, 40).

(c) Respondent had shipped prior to the trial 443,729 of the accused jacks. (Ex. N and O).

## QUESTIONS PRESENTED

The facts of the case present a single question which will first be phrased broadly and will then be phrased with specific reference to the facts of the present case:

In the complete absence of prior art requiring a narrow interpretation, is the Court justified in basing a finding of non-infringement upon a limitation not specifically recited in the claim but read into the claim by the Court?

Specifically, considering the importance of the invention and its significant impact on the industry, was the Court below justified in the present case in basing a find-



ing of non-infringement upon a limitation to a planar relationship not expressed in the claim, but which the Court arbitrarily supplied to support its findings, despite the fact that the claim is applicable verbatim to the accused structure and *the accused structure shows appropriation of the invention* with almost complete realization of the several objectives of the invention?

### REASONS FOR GRANT OF WRIT OF CERTIORARI

The discretionary power of this Court is invoked upon the following grounds:

1. The decision rendered in this case by the Circuit Court of Appeals for the Seventh Circuit is in conflict with the decision of the Circuit Court of Appeals for the Sixth Circuit in *Cincinnati Cadillac Co. vs. English Mersick Co.*, 18 Fed. (2) 542 and with the decision of the Circuit Court of Appeals for the Second Circuit in *Samson-United Corporation vs. Sears Roebuck & Co., Inc.*, 103 F. (2) 312, (certiorari denied, 307 U.S. 638), and with the decision of the Circuit Court of Appeals for the Eighth Circuit in *Kansas City Southern Railway Co. vs. Silica Products Co.*, 48 F. (2) 503.

2. In this case, the Circuit Court of Appeals for the Seventh Circuit has decided an important question of federal law which has not been, but should be, settled by this court and as to which the decision of the Seventh Circuit Court of Appeals is probably in conflict with decisions of this Court in so far as the same are applicable.

Wherefore your Petitioner respectfully prays that a writ of certiorari issue out of, and under the seal of, this Court, directed to the United States Circuit Court of Appeals for the Seventh Judicial Circuit, commanding

said Court to certify and send to this Court, on a date to be designated, a full transcript of the record and full proceedings had in this case, to the end that this case may be reviewed and determined by this Court as to the questions presented hereby, and that the judgment of the Court of Appeals for the Seventh Circuit be reversed in so far as it found the Respondent not to have infringed claim 6 of the Petitioner's patent No. 2,038,974; and that Petitioner may be granted such other and further relief as may seem proper.

*Respectfully submitted,*

S. L. WHEELER,  
*Counsel for Petitioner.*

Dated at Milwaukee, Wisconsin  
July 28, 1943.

## BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI

### OPINIONS BELOW

The Opinion of the District Court (Tr. 146) was rendered July 11, 1942, and is reported in full in the opinion of the Circuit Court of Appeals.

The Opinion of the Court of Appeals for the Seventh Circuit (Tr. 273) was rendered April 30, 1943, and published 57 Pat. Q. 268; 135 F. (2d) 187.

### JURISDICTION

1. The date of judgment to be reviewed is April 30, 1943.

2. The judgment was rendered in a Civil Action brought under the patent statutes to determine issues of validity and infringement of Letters Patent for invention.

3. The statute under which jurisdiction is invoked is 240a of the Judicial Code, 28 U.S.C.A. 347, as amended by the Act of February 13, 1925.

4. Cases believed to sustain the jurisdiction are:

*Carbice Corp. vs. American Corp.*, 283 U.S. 27.  
*Morton Salt vs. Suppiger*, 314 U.S. 488.

### STATEMENT

For the facts generally, please see the Petition.

While the facts have been generally stated in the Petition, the Court may desire a more particular mechanical description of the jack of the patent in comparison with that accused as an infringement.

The hydraulic jack illustrated in the patent is of a type used to lift automobile and truck axles and wheels

while tire repairs are being made. Each jack is a small, self-contained unit, necessarily compact for convenient transportation and to enable it to be reached beneath the axle.

The fundamental parts of any hydraulic jack are a flat bottomed "base", a ram and ram cylinder extending vertically above the base, a reservoir for a supply of oil, a pump to draw oil from the reservoir and pass it under pressure to the base of the ram cylinder, whereby to force the ram upwardly and lift the load, and ducts for the passage of oil to and from the various parts of the jack, with check valves controlling oil flow from the reservoir to the ram cylinder, and a release valve by-passing the check valves to permit a reverse flow of oil from the ram cylinder to the reservoir for lowering the ram.

Leakage was a serious problem in prior art jacks. Some of the intercommunicating passages of a jack are subject to the high pressure of the pump and ram cylinder, whereas other passages are subject only to the low pressure of the reservoir. Prior art jack constructions were such that the high pressure passages had to be bored into the jack from the outside and thereafter externally closed by screw plugs, at which leakage occurred. One of the objects of the present invention is to reduce the number of places where high pressure leakage can occur externally around such plugs.

Another problem in the art was to accommodate the various parts upon a base of standard size. In the prior art jacks, the ram and its cylinder had to be located too near one end of the base in order to make room for the pump at the other end, thus positioning the load eccentrically of the supporting surface and tending to permit the jack to tip easily under load. The present jack

solves that problem by its novel disposition of the pump and permits the ram and its cylinder to be nearly centered on the base.

Another problem of the prior art jacks was excessive height. Although there is a very limited clearance available beneath an automobile axle, the range of lift required is great. Insofar as prior art constructions require the location of ducts beneath the ram, an undue height of the collapsed jack was inevitable and it became difficult to manipulate the jack beneath the axle of a car having a deflated tire. The particular organization to which the claim in suit is directed solves this problem and permits of an unusual degree of ram extension in proportion to the overall height of the collapsed jack.

In solving all of the several problems above described, an outstanding feature of the Plaintiff's invention is the novel characteristic of the oblique angular position of the pump in which it is disposed intermediate the ram and the release duct.

Referring to the drawing of the patent in suit (Tr. 158), the ram cylinder is shown at 12. The ram, which moves like a piston vertically in the cylinder, is designated by reference character 10. The reservoir 14 for low pressure oil surrounds the ram cylinder and is formed by a sleeve 13 spaced from the cylinder.

The release duct 38, closed at its outer end by a needle valve 40, 41, is not quite horizontal.

The pump chamber 25 is located at an angle almost bisecting the angle between the vertical ram cylinder 12 and the release duct 38. Operating in the pump chamber is the pump plunger 26, reciprocated by handle

56. As the pump plunger moves upwardly in the chamber, it draws oil from reservoir 14 through duct 30 past the check valve 45. As the plunger 26 moves downwardly in the pump chamber 25, it forces check valve 45 to its seat and the oil escapes through check valve 36 into duct 37, which communicates with the release duct 38, leading to the ram cylinder. Pressure of oil thus forced into the bottom of the ram cylinder acts on the ram to raise it and its load.

When the needle valve 40, 41 is retracted from its seat, the oil in the ram cylinder by-passes the check valves and the pump and is permitted to flow through duct 42, 43, 33 back to the duct 30 and thence back to the reservoir. This allows the load on the ram to lower the ram in the cylinder 12. As long as the needle valve 41 remains seated the check valves will prevent any return flow of the oil and will hold the load on the ram in its elevated position.

As shown in the patent, the organization is such that all ducts which in any manner penetrate to the outside of the jack are low pressure ducts. If any oil whatever leaks from a high pressure duct it will be intercepted by a low pressure duct which will return it to the reservoir.

The position of the pump chamber intermediate the ram cylinder 12 and the release duct 38 at the oblique angle in which it is illustrated in Figure 1, is the primary feature, which, in the combination set forth in claim 6, permits the concentration of the various ducts to reduce the number of high pressure plugs previously required, and, at the same time, to enable the jack to be very compact when the ram is retracted in proportion to the unusual amount of ram extension which is possible.

The Respondent's accused construction is illustrated, while at the same time claim 6 in suit is applied, element by element thereto, as follows:

(The drawing is a reproduction of Defendant's Ex. K, to which Petitioner has applied reference characters identified with the claim elements as recited below).

### CLAIM 6

A hydraulic jack comprising the combination with—

A—an upright cylinder, and

B—a concentric reservoir, of

C—a base with which said cylinder and reservoir are in liquid tight relation

D—a ram operative in said cylinder

E—a duct in said base leading directly from the bottom of said cylinder to an exterior side surface of the base, and

F—provided at an intermediate point with a valve seat shoulder.

G—a bleed valve threaded in said duct for axial adjustment therein to and from said shoulder

H—a pump chamber formed in said base and opening therefrom along an axis inclined with reference to said cylinder and intermediate said cylinder and said duct

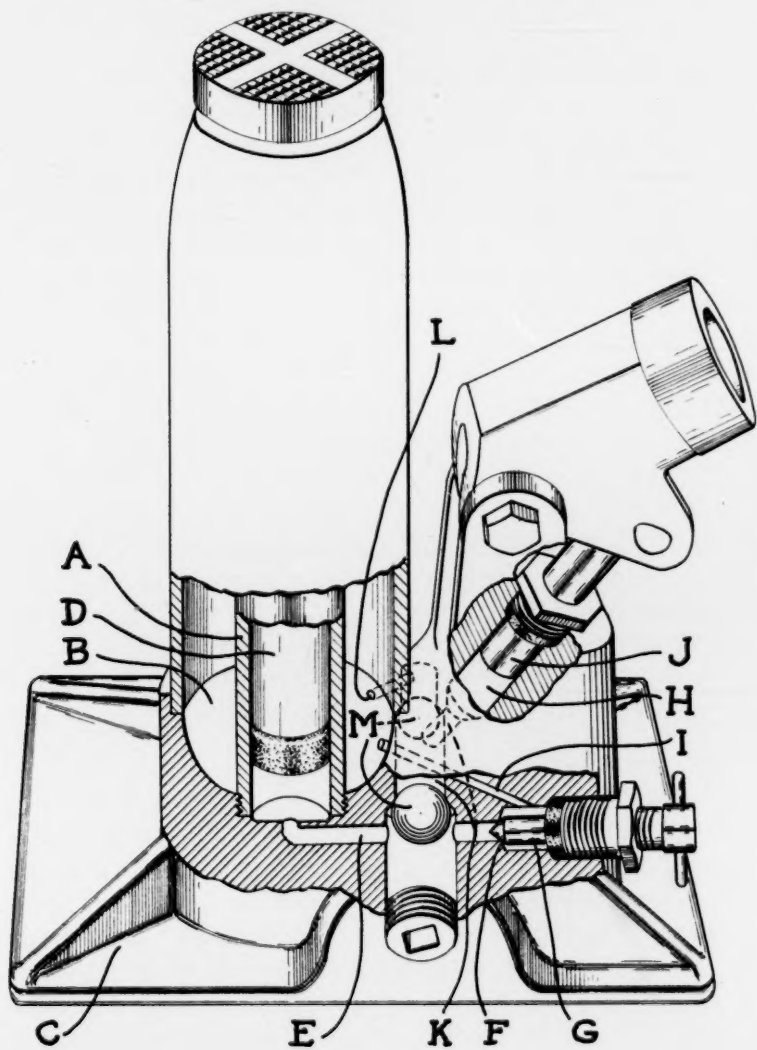
I—a by pass duct leading from said first mentioned duct externally of said shoulder to said reservoir

J—a pump plunger operative in said chamber

K—a high pressure duct extending from the chamber to the first mentioned duct

L—and a supply duct in communication with the reservoir and leading to the high pressure duct

CLAIM 6 AS APPLIED TO DEFENDANT'S JACK







M—and check valves at the junction of the supply duct with the high pressure duct whereby to control liquid urged by the plunger from said reservoir to the cylinder.

As can be seen from the above cut, Respondent's ram cylinder A and his release duct E are in a common vertical plane from which his pump chamber H is slightly offset laterally. Due to the lateral offset, Respondent does not concentrate the ducts of its jack quite as effectively as is suggested by the Patent in suit. Consequently, Respondent uses as part of his duct system a transverse connecting duct to which the lead line from reference character K extends in the cut and which requires a single high pressure plug at one of its ends. However, notwithstanding the offset, the intermediate location of the pump chamber in the accused jack construction shown in the cut enables Respondent to reduce the number of high pressure plugs to a single plug (in contrast with three to seven high pressure plugs which it had found necessary in previous jack constructions). In addition, the Respondent's use of the intermediate position of the pump chamber has enabled Respondent to bring its ram cylinder closer to the center of the base without increasing the height of the jack when the ram is retracted.

The oblique angular location of the pump chamber, whereby it is located intermediate the ram cylinder and the release duct, is completely new in the combination claimed. It has consistently been Petitioner's position that no reference or combination of references shows or suggests the invention in suit. The Respondent's expert witness has not made any contention to the contrary. Respondent has not, in the Courts below, show any prior art anticipating or limiting the claims in suit.

## SPECIFICATION OF ERRORS

The errors which Petitioner will urge if the Petition for Certiorari is granted, are that the Circuit Court of Appeals for the Seventh Circuit erred:

1. In holding claim 6 not infringed by Respondent's accused construction.

2. By importing into claim 6 in suit a dispensable limitation not recited in the claim, and thereby enabling Respondent to escape the consequences of its appropriation of the invention.

3. In interpreting claim 6 in suit in a manner contrary to the normal and natural meaning of its language.

4. In assigning to claim 6 in suit a narrower interpretation than that to which it is entitled on its face, in the complete absence of any prior art requiring such restricted interpretation.

5. In requiring complete achievement of all possible advantages of the patent as a test of infringement instead of applying the language of claim 6 of the patent in suit.

6. In finding non-infringement because Respondent imperfectly practices the invention of claim 6 of the patent in suit to obtain only the majority of its benefits without obtaining all of them fully.

## SUMMARY OF ARGUMENT

1. Accepting claim 6 of the patent in suit at its face value, the claim is infringed.

2. The prior art affords no basis for accepting claim 6 of the patent in suit at less than its face value.

3. The patent in suit is an important patent, licensed to one large jack manufacturer, extensively infringed by Respondent, and respected by two other substantial jack manufacturers who imitated the construction when it appeared on the market but discontinued their infringement upon notice.

4. A claim should not be narrowed by importing into it, by construction, any dispensable element in order to enable an infringer to escape the consequences of his infringement.

5. One should not escape infringement by practicing the invention imperfectly.

6. The equities favor your Petitioner.

7. The question as to the extent to which, if at all, limitations not requisite to validity or to eliminate ambiguity may be imported into a patent claim by Court interpretation is an important question upon which this Court has not passed.

## ARGUMENT

### Point I. Claim 6 is Infringed.

Infringement may be either a question of fact or a question of law, depending on the particular point raised.

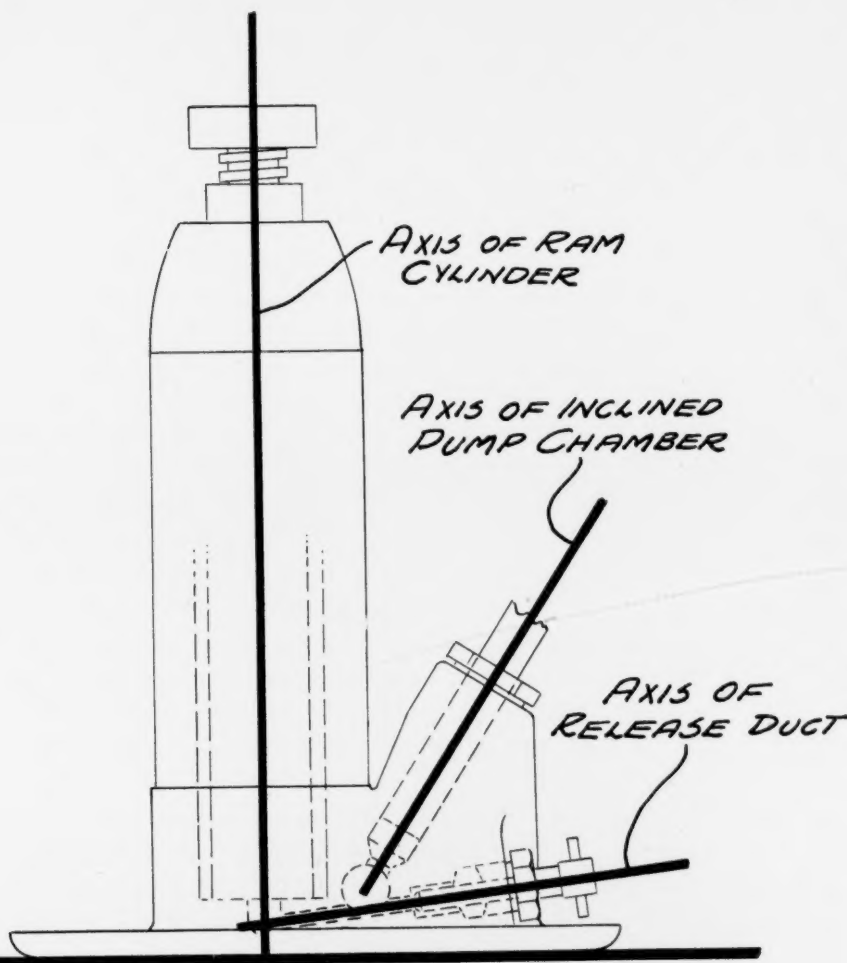
In the present case the Lower Court's finding of non-infringement is based upon its concept of the law. There can be no question, as shown above in the Statement of facts, that the language of claim 6 is applicable verbatim to Respondent's accused jack. It has been applied to the jack.

Respondent, however, contends that because its pump chamber is offset from the plane of the ram cylinder and the relief port, it is not intermediate.

The claim is not so limited. We have here a very important invention which has had a notable impact upon the art. To say the least, therefore, the claim is entitled to the broadest interpretation which its language will bear in the light of the art. The art will be discussed later. Assuming for the moment that a broad interpretation is permissible, what, then, is the normal and natural meaning of the word "intermediate"?

If a traveler uses train service from Milwaukee to St. Louis, Chicago is intermediate Milwaukee and St. Louis. The train will necessarily pass through Chicago. It is true that a perfectly straight line drawn from Milwaukee to St. Louis will not pass through Chicago, but by all means of travel and by all normal human experience Chicago is in fact intermediate Milwaukee and St. Louis. So, in terms of geographical location and in terms of function of the pump in a hydraulic jack, Respondent's pump chamber is intermediate the release duct and the axis of the ram cylinder. Inspection of Respondent's jack in side elevation will show that the pump axis virtually bisects the angle formed between the release duct and the ram axis in exactly the same manner and to exactly the same extent as in the patent. (See the annexed diagram).

In a hydraulic jack the intermediacy of the pump in an inclined position between the release duct and the ram, signifies that it is *intermediate*, not only geographically but functionally, in terms of pumping fluid between these parts, and from the reservoir which is concentric with the ram cylinder and has the same axis.



Such intermediacy is not avoided by offsetting the pump laterally while preserving the general relationship which enables Respondent to achieve most, if not all, of the advantages of the patent. After all, the offset of Respondent's pump chamber is but a fraction of an inch, and, considering the significance of the invention, it is indeed a poor rule of law which would enable a copyist to escape responsibility for his piracy merely because of so slight a change.

## Point II. The Prior Art.

The claim language was not chosen to distinguish from the prior art. No art is cited of record which approaches the subject of the claim in any way to require a limited interpretation of the word "intermediate". On the contrary, the word "intermediate" was used in the claim merely to indicate the general position of the inclined pump chamber which enabled Petitioner in the patent, and Respondent in the accused jack, to concentrate in each instance the ducts leading to and from the reservoir, the pump, and the ram cylinder.

In view of the proceedings below and the failure of the Trial Court or the Court of Appeals to discuss the prior art, and the failure of Respondent to point out any prior art which requires the limitation asserted for the claim in the Court of Appeals, it is probably needless for Petitioner to discuss the prior art in detail. The patents which show inclined pump chambers include No. 24,759, July 12, 1859 (Tr. 170), and No. 569,574, October 13, 1896 (Tr. 176). In neither of these patents is the inclined pump so located that it can possibly be said to be intermediate in any sense, and in neither of these patents is there anything approaching the combina-

tion to which claim 6 in suit is directed. The most recent of these patents is 47 years old. If any of them had taught the art the intermediate position of a pump chamber in a jack combination as claimed, the art would long since have adopted this construction.

### Point III. The Importance of the Patent.

The fact that four large jack manufacturers, including Respondent, and Petitioner's Licensee, and the two which discontinued infringement upon notice, all adopted this construction immediately after Petitioner invented it, is cogent evidence of the importance and merit of the invention and the complete lack of any suggestion thereof in the prior art.

### Point IV. A Claim Should Not be Narrowed by Judicial Construction.

In the case of *Cincinnati Cadillac Co. vs. English Mersick Co.*, 18 Fed. (2) 542, Judge Moorman wrote an opinion for the Sixth Circuit Court of Appeals, in which he said:

"It is manifestly true that the courts are without power to enlarge or restrict a claim, for the purpose of making out a case of validity or infringement." (citing cases).

The court proceeds to state that a claim may be construed either in the light of its specification or the prior art "not for the purpose of expanding or limiting it, but for the purpose of making it operative or ascertaining its true meaning". In this connection the court cites its own decision in the case of *Crown Cork & Seal Co. vs. Sterling Cork & Seal Co.*, 217 Fed. 381, and also



cites *Westinghouse vs. Boyden*, 170 U. S. 537, both of which are leading cases on this issue.

In the Cincinnati Cadillac case the issue was one of validity, infringement being admitted. In the present case so little point has been made of any issue of validity that validity is apparently conceded, and the prior art, as above noted, wholly fails to impose any limitation on a claim which on this record must be accepted as valid. Yet the court has taken this claim, which, in any ordinary meaning of the language used would require a finding of infringement, and has distorted one of the words in the claim out of its normal and usual meaning in such a way as to add to the claim a limitation not expressed therein.

Not only does the claim contain no limitation requiring the pump chamber to be in the same plane as the ram cylinder and the release duct, but, as noted in the Petition, claims containing this limitation were considered by the Patent Office and were cancelled. The cancellation of all claims referring to any co-planar relationship between these parts gives added effect to the intent of the Patentee and the Patent Office to allow a claim which does not contain this limitation.

In the case of *Morgan Envelope Co. vs. Albany Paper Co.*, 152 U. S. 425, 429, this court held that where a change made in the Patent Office was a broadening one, it could not be construed away even to save the validity of the patent. How much less should it be permitted to be construed away where the effect of the change is to hold an obvious infringer?

*Walker on Patents, Dellers Edition*, Volume 2, page 1207, says:

"On the other hand, a claim will not be narrowed by importing into it, by construction, any dispensable element, in order to enable an infringer to escape the consequences of his infringement."

In *McClain vs. Ortmyer*, 141 U.S. 419, 425, this court said:

"In a case of doubt, where the claim is fairly susceptible of two constructions, that one will be adopted which will preserve to the patentee his actual invention."

In *Topliff vs. Topliff*, 145 U.S. 156, 171, this court said:

"The object of the patent law is to secure to inventors, a monopoly of what they have actually invented or discovered and it ought not to be defeated by too strict a technical adherence to the letter of a statute or by the application of artificial rules of interpretation."

What could be more artificial than the interpretation given the word "intermediate" in the court below?

### Point V. Imperfect Infringement is Still Infringement.

As opposed to the conclusion of the court below that Respondent escapes infringement because he still has to use one high pressure plug, the fact is that the claim in suit contains no reference whatever to the presence or absence of any plug. The court has, in effect, substituted a test for infringement based on results for one based on the language of the claim. It is almost too fundamental to require mention here that the scope of a patent is determined by its claims. This is statutory. (R.S. 4888, *U. S. Code, Title 35, Section 33*).

In *Continental Paper Bag Co. vs. Eastern Paper Bag Co.*, 210 U.S. 405, 419, this court said:

"The claims measure the invention".

That the claim in suit reads verbatim upon the accused jack has been demonstrated. Yet the Court of Appeals, in the short paragraph considering the issue of infringement, refers first of all to the fact that the ducts in Respondent's device are not in the same plane (the claim does not require that they be in the same plane). The Court of Appeals then refers to the cross drilling of Respondent's jack (the claim does not exclude the possibility of cross drilling). The Court of Appeals then refers to the cross drilling being plugged at its outer end, thus requiring a high pressure seal at this point (The claim does not exclude a construction employing a high pressure seal and does not refer at all to the presence or absence of a plug.

Where it so clearly appears that the essence of the claimed invention is the intermediate location of an inclined pump chamber between the ram cylinder and the release duct in a general combination which permits of the concentration of the ducts at the lower end of the pump chamber, and when it appears that Respondent has this arrangement and has accomplished this concentration, and thereby has achieved many of the objectives of the patent in suit, why should he be released from responsibility from his infringement merely because he has not achieved them all?

In *Auditorium Corp. vs. Greater Rochester Properties*, 59 F. (2), 450, the court said:

"Nor is impairment of a function, or even a mere mechanical improvement or new coordination of parts without achieving a new result, an excuse for

appropriation of a prior invention covering the same idea of means. Whatever changes have been made in defendant's adaptations are simply colorable without any new system of operation."

In the case of *Kansas City Southern Railway vs. Silica Products Co.*, 48 F. (2) 503, the court said:

"If in some slight particular there has been a variance and the result has been a product of the patent, this will not avoid infringement 'one does not escape infringement by practicing the invention imperfectly'." (Citing cases).

In the U. S. District Court for the Eastern District of New York in the case of *Syracuse Chilled Plow Co. vs. LeRoy*, 233 Fed. 682, the Court said:

"It makes no difference that Defendant does not adapt its construction to attain all the benefits of the patent in suit."

#### Point VI. The Equities Favor Petitioner.

Petitioner cannot overlook the fact that whatever Respondent knows about the accused jack is based upon Petitioner's own disclosure of his invention to Respondent long before his patent issued.

Respondent had copied that invention and had the accused jack on the market before Petitioner had his patent. The facts in this regard have not been traversed on the record.

#### Point VII. The Important Issue of Interpretation Here Raised Requires Adjudication in This Court.

In the leading case of *Westinghouse vs. Boyden*, 170 U.S. 537, this court laid down some broad rules of claim interpretation requiring in general that the lower courts

give to patent claims such scope as the nature of the invention warrants. Insofar as the mandate of the Westinghouse case is applicable here, the decision of the Court of Appeals is in derogation thereof. It has been shown above that the art does not impose upon the claim in suit any such limitation as has been ascribed to that claim by the Court of Appeals. It has been shown above that the interpretation ascribed to the claim by the Court of Appeals is a strained interpretation, repugnant to the natural meaning of the words.

It is believed that this Court has never passed upon the precise question here involved as to whether it is not arbitrary for a court to allow an infringer to escape the consequences of his acts merely because he imperfectly practices the invention as a result of offsetting a part for less than an inch from the position which it would have if all of the objectives of the patent were fully to be obtained.

Where the claim language applies to the accused construction, and infringement would therefor seem to follow logically under the statute, does the infringer nevertheless have to have *all* the objectives of the patent, as well as the claimed structure, before he can be held responsible? This is a question which it is believed that this Court has never decided, and is one of importance as indicated not only by the present case, but by the decisions in the cases cited supra, *Auditorium Corp. vs. Greater Rochester Properties*, 59 F. (2) 450, (W. D. New York); *Syracuse Chilled Plow Co. vs. Leroy Plow Co.*, 233 Fed 682, (W. D. New York); and *Kansas City Southern Railway Co. vs. Silica Products Co.*, 48 F. (2), 503, (C.C.A. 8th), as well as the decision in *Cincinnati Cadillac Co. vs. English Mersick Co.*, 18 F. (2), 542, (C.C.A. 6th).

## CONCLUSION

Wherefore Petitioner earnestly prays that a writ of certiorari be granted; the case be reviewed; and the Decree of the Court of Appeals for the Seventh Circuit finding non-infringement of Werner patent No. 2,038,974 be reversed.

*Respectfully submitted,*

S. L. WHEELER,

*Counsel for Petitioner.*

606 West Wisconsin Avenue,  
Milwaukee 3, Wisconsin.  
July 28, 1943.

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AUG 30 1943

CHARLES ELMORE CROPLEY  
CLERK

IN THE  
**Supreme Court of the United States**

OCTOBER TERM, 1943.

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**No. 210**

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RICHARD W. WERNER,

*Petitioner,*

*vs.*

HEIN-WERNER MOTOR PARTS CORPORATION,  
A WISCONSIN CORPORATION,

*Respondent.*

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**BRIEF FOR RESPONDENT IN OPPOSITION TO  
PETITION FOR WRIT OF CERTIORARI.**

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ARTHUR H. BOETTCHER,

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53 West Jackson Blvd.,  
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August 28, 1943.

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**BRIEF FOR RESPONDENT IN OPPOSITION TO  
PETITION FOR WRIT OF CERTIORARI.**

---

The Circuit Court of Appeals for the Seventh Circuit found Werner Patent No. 2,038,974 not infringed by the hydraulic jack accused, and the patentee petitions for review on writ of certiorari.

Respondent opposes the petition.

This is a plain case of a finding of non-infringement, on the facts and under well-settled law.

The trial court and the court of review found, as a fact, that

“There is no identity of result or substantial identity of means.” (Tr. pp. 149, 276.)

That, under the law, spells non-infringement.

There is nothing involved warranting the attention of this Court.

*Keller v. Adams-Campbell Co.*, 264 U. S. 314, 318, 319.

*Layne &c. Co. v. Western Well Works*, 261 U. S. 387, 388, 392, 393.

There is no conflict as alleged (Petition, p. 6), nor is there involved any unsettled question of federal law (Petition, p. 6).

Petitions for writs of certiorari are not granted merely to give the defeated party in the Circuit Court of Appeals another hearing.

*American Construction Company v. Jacksonville, Tampa and Key West Railway Company*, 148 U. S. 372, 382.

*Magnum Import Company, Inc. v. Coty*, 262 U. S. 159, 163.

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Referring now to petitioner's "Summary Statement of Matter Involved" (Petition, pp. 2-5), point by point:

1.

The main issue in this case was that of infringement,—*i. e.*, what was the alleged invention disclosed by the patentee, and did the defendant appropriate it?—and "claim interpretation" (Petition, p. 2) was involved simply as the usual adjunct to that question.

2.

It is not correct to say that validity of the claim "has not been seriously challenged" (Petition, p. 2). It was defendant's position that the claim was invalid because it did not comply with Section 4888 of the Revised Statutes

and because it lacked the quality of invention over the prior art; the trial court and the court of review did not pass upon either of these issues because their findings of non-infringement were determinative of the case (Tr. pp. 146, 149, 273, 276).

## 3.

The claim is not "applicable verbatim" to the accused jack (Petition, p. 2). Even if it were, that alone would not be the test.

*Westinghouse v. Boyden Power Brake Co.*, 170 U. S. 537, 568.

Petitioner states that the trial court and the court of review found non-infringement "on the basis of an interpretation of the claim which involves the reading into the claim of a limitation not expressed therein" (Petition, pp. 2, 3).

That is not correct.

The courts simply read and interpreted the claim in the light of the specification and drawings, as required by law.

*Schriber Co. v. Cleveland Trust Co.*, 311 U. S. 211, 217.

*Snow v. Lake Shore, &c., Railway Co.*, 121 U. S. 617, 628-630.

## 4.

Petitioner says (Petition, p. 3):

"A major feature of the jack of the patent is the oblique angular position of the pump chamber, *whereby* it is intermediate the vertical ram cylinder and the almost horizontal release duct." (Italics supplied.)

as if "oblique angular position of the pump chamber" and "intermediate the vertical ram cylinder and the almost horizontal release duct" meant one and the same thing, the latter merely explanatory of the former.

An oblique pump chamber either may or may not be intermediate the ram cylinder and the release duct.

*In the patent* there is an oblique pump chamber and it is intermediate the ram cylinder and the release duct.

And the claim says:

“a pump chamber formed in said base and opening therefrom along an axis inclined with reference to said cylinder *and* intermediate said cylinder and said duct.” (Tr. p. 161, col. 2, lines 39-42.) (*Italics supplied.*)

## 5.

Petitioner states that the combination of the claim makes possible a reduction in the number of plugs exposed to high pressure (Petition, p. 3). In fact, it *eliminates* plugs exposed to high pressure; that was the object of the patentee (Patent, p. 1, col. 1, lines 22-40, Tr. p. 159).

Petitioner also states that the combination of the claim “permits the ram cylinder to be centered on the jack base” (Petition, p. 3). The ram cylinder of the patent is no more centered than in prior art instances (Tr. pp. 164, 198, 216, 263), and the patent specification makes no point of any such feature.

## 6.

Petitioner states (Petition, p. 3):

“Respondent’s accused jack was designed before issue of Petitioners’ patent with full knowledge of Petitioner’s invention, which had been disclosed to Respondent by Petitioner in connection with the offer of a license (Tr. p. 18).”

Respondent’s jack was designed before issue of petitioner’s patent. Beyond that, the statement is mere assertion by counsel without foundation in the record. The citation of page 18 of the Transcript is itself enough to show the lack of evidence in this regard.

## 7.

Respondent's jack does not use the intermediately located pump chamber of the patent in suit.

Nor does it achieve the purposes of the alleged invention at bar.

There is no point here in merely reducing the number of plugs. Defendant had twice previously reduced the number of its plugs, always by the same shop technique.

## 8.

Respondent based its contention of non-infringement on the fact that its jack is characterized by an utterly different principle of construction from that of the patent in suit, and on the lack of that substantial identity of means and identity of result which are essential to infringement.

*Yale Lock Company v. Sargent*, 117 U. S. 373, 378.

*Werner v. King*, 96 U. S. 218, 230.

*Burr v. Duryee*, 68 U. S. 531, 572, 573.

*Kokomo Fence Machine Co. v. Kitselman*, 189 U. S. 8, 24.

There is nothing "slight" about the offset to which petitioner refers. It is a very substantial offset, indigenous to an utterly different rationale of device than that of the patent. Respondent is not making point of mathematical exactness. A "slight" or "colorable" offset would be one that would not change the principle of construction. Here the principles of construction of the two devices are utterly different.

Nor is this a case of imperfect practice of an invention. Here, respondent does not practice the invention at bar at all.

## 9.

Any novelty that can be predicated of location of the pump chamber of the patent intermediate the ram cylinder and the release duct must be a matter of its geographic location, and whatever function is performed because of that location becomes an essential characteristic of the patent. That function is due to the placing of all three in the same plane, whereby cross-drilling and external plugging incident thereto are dispensed with.

The pump chamber of respondent's jack is not geographically and functionally intermediate the ram cylinder and the release duct, in the sense in which the term "intermediate" is normally used, and certainly in the sense in which it is used in the patent claim.

There is but one objective of the patent, at least so far as the claim in suit is concerned, and that is to do away with high pressure plugs; and respondent's jack does not achieve that objective. It avoids leakage by careful shop practice in making its plugs tight.

The provisions of Claim 6 of the patent in suit that the pump chamber be intermediate the cylinder and the release duct can mean nothing other than that the three be co-planar, and the trial court and the court of review correctly found that respondent's jack did not infringe.

## 10.

The Caldwell Patent 569,574 (Tr. p. 176) is a prior art instance of an inclined pump chamber intermediate the ram cylinder and the release duct,—though in this instance the reservoir surrounds the pump chamber instead of the ram cylinder.

Petitioner argues as if anything and everything shown in his patent, not duplicate of the prior art, is an invention and covered by his claim.

Respondent's position is that the claim can cover only an invention taught by the disclosure.

# 11.

Petitioner states that during pendency of the application for the patent in suit, claims referring to the location of the ducts in a single plane "were considered" (Petition p. 5).

What it amounts to, and all it amounts to, is that, at one time, claims using the phraseology—"a plurality of conduits formed in said mass substantially in a vertical plane"—were submitted, rejected, and cancelled for reasons applicable to the claims as a whole.

Petitioner's argument is that the fact that the claim in suit does not employ that phraseology "indicates intent on the part of the Commissioner of Patents not to qualify the allowed claim in this respect" (Petition, p. 5).

No such conclusion follows, and there is no such doctrine.

Respondent's position is that saying that the pump chamber is intermediate the cylinder and the release duct is just another way of saying that the three are in the same plane.

# 12.

Petitioner asserts that "The invention in controversy has been extensively recognized by the industry" (Petition, p. 5).

That is not correct.

# (a)

Petitioner's one licensee has made and sold some 100,000 to 125,000 jacks, like the patent (Tr. p. 139), over a period of about eight years. It made a great many more jacks upon which it paid no royalties and as to which it declines to comply with petitioner's demand for royalties; in other

words, petitioner's licensee not only does not recognize the patent in suit beyond the construction which the patent illustrates; it refuses to do so (R. p. 33).

(b)

As to the "Two large jack manufacturers" who are said to have copied plaintiff's construction and, when charged with infringement, to have "changed their construction in recognition of the patent" (Petition, p. 5), it will be seen from the cited references to the transcript, that nothing either pertinent or material is established. Moreover the accused products of those manufacturers had their cylinders, pumps, and ducts in the same plane, and it may have been prudent on their part to drop that design; but that has nothing to do with this case.

(c)

Respondent's jacks do not embody the alleged invention of the patent.

---

Under "Questions Presented" (Petition, p. 5), petitioner presents a single question, phrased broadly as follows:

"In the complete absence of prior art requiring a narrow interpretation, is the Court justified in basing a finding of non-infringement upon a limitation not specifically recited in the claim but read into the claim by the Court?"

Firstly, as already stated, petitioner argues as if anything and everything shown in his patent, not duplicate of the prior art, is an invention and covered by his claim,—certainly an untenable position.

Secondly, the trial court and the court of review did not find non-infringement upon a limitation not specifically recited in the claim. The limitation upon which they found non-infringement is specifically recited in the claim. The courts did not "read" anything "into" the claim. They



merely read the claim in the light of the disclosure, as required by law.

*Schriber Co. v. Cleveland Trust Co.*, 311 U. S. 211, 217.

*Snow v. Lake Shore &c. Railway Co.*, 121 U. S. 617, 628-630.

Petitioner's "specific" phrasing of the question presented is replete with controverted assertions.

The alleged invention is not important.

It made no "significant impact on the industry."

The trial court and the court of review did not base their finding of non-infringement upon something not expressed in the claim "but which the Court arbitrarily supplied." The claim, in fully equivalent language, calls for the planar relationship taught by the patentee,—which respondent does not have.

The claim is not applicable verbatim to the accused structure. Nor is it applicable in substance or spirit.

There was no appropriation by respondent of the alleged invention of the patent, and no realization of its objective or objectives.

---

Under the heading "Reasons for Grant of Writ of Certiorari" (Petition, p. 6), petitioner asserts (1) conflict between the decision rendered in this case by the Circuit Court of Appeals for the Seventh Circuit and the decisions in the following cases:

(a) *Cincinnati Cadillac Co. v. English Mersick Co.*, 18 Fed. (2d) 542, C. C. A. Sixth Circuit;

(b) *Samson-United Corporation v. Sears Roebuck & Co., Inc.*, 103 Fed. (2d) 312, C. C. A. Second Circuit; and

(c) *Kansas City Southern Railway Co. v. Silica Products Co.*, 48 Fed. (2d) 503.

There is no conflict.

## (a)

*Re Cincinnati Cadillac Co. v. English Mersick Co.:*

This decision, in this regard, simply holds that courts are without power to enlarge or restrict a claim for the purpose of making out a case of validity or infringement.

The courts in the instant case assumed no such power. They simply followed the law which the Court in the *Cincinnati v. English* case goes on to refer to,—i. e., that they may construe the claim in the light of the specifications and the prior art “for the purpose of making it operative or ascertaining its true meaning,”—citing, in this latter connection, the opinion of this Court in *Westinghouse v. Boyden Power Brake Co.*, 170 U. S. 537 (See pp. 557, 558).

## (b)

Counsel for petitioner does not explain his point in respect of the *Samson-United v. Sears Roebuck* case, and we do not see what his point could be. As we see it, it is simply a holding of validity and infringement on the particular facts of that case.

## (c)

The point which petitioner makes of the *Kansas City Southern v. Silica Products* case is that it holds that “One does not escape infringement by practicing invention imperfectly.” There the defendants “followed the process of the patent with substantial closeness,” and the fact that their product was inferior was held to be immaterial. Here, the defendant neither uses the principle of nor accomplishes the object of the patent.

The petitioner (Petition, p. 6) also asserts (2) that “the Circuit Court of Appeals for the Seventh Circuit has decided an important question of federal law which has not

been, but should be, settled by this court and as to which the decision of the Seventh Circuit Court of Appeals is probably in conflict with decisions of this Court insofar as the same are applicable."

As to the first portion of the foregoing, we simply state again that all that that Circuit Court of Appeals did in this case was to find non-infringement on the facts and under well settled law.

As to the latter portion, we are not sure that we know what it means; it appears to say that the decision of the Circuit Court of Appeals fails to follow the decisions of this Court, but we submit that it is clear that that is not correct.

---

Petitioner's "Brief in Support of Petition for Writ of Certiorari" is really re-argument of the case. It comprises (including drawings) eighteen pages. (His main brief in the Circuit Court of Appeals comprised, including drawings, seventeen pages, his reply brief five.)

That we do not consider in compliance with the Rules, and we do not reply to its detail.

We content ourselves with presenting three drawings of defendant's device which, we submit, speak for themselves.

The drawing which appears opposite page 12 of petitioner's brief is *not* Defendant's Exhibit K as stated by petitioner on page 12.

It is Plaintiff's Exhibit 16, and, in the trial court and in the court of review, we criticized that exhibit as insufficiently illustrative and submitted defendant's illustrations, Defendant's Exhibits K and L, hereto annexed, in order fully to inform those courts.

We also criticize the drawing opposite page 16 of petitioner's brief. It is illusory. It is a diagram, in elevation from *the side only*, and which therefore makes it appear as if the three axes are in one plane, which would mean a pump chamber intermediate the ram cylinder and the release duct.

But we are, of course, dealing with a three-dimensional object, and, when we look at a companion elevation of *the front* of the device (*i. e.*, 90° from the plane of projection of petitioner's diagram), we get a very different picture, which we submit opposite this page.

#### CONCLUSION.

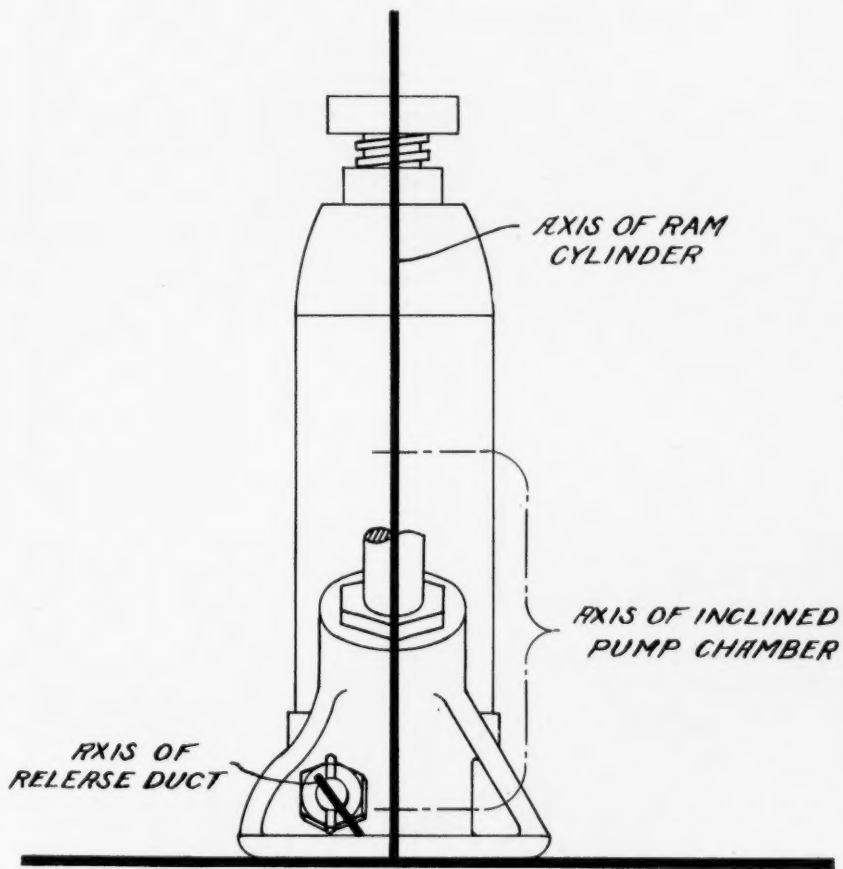
The petition for a writ of certiorari should be denied.

Respectfully submitted,

ARTHUR H. BOETTCHER,

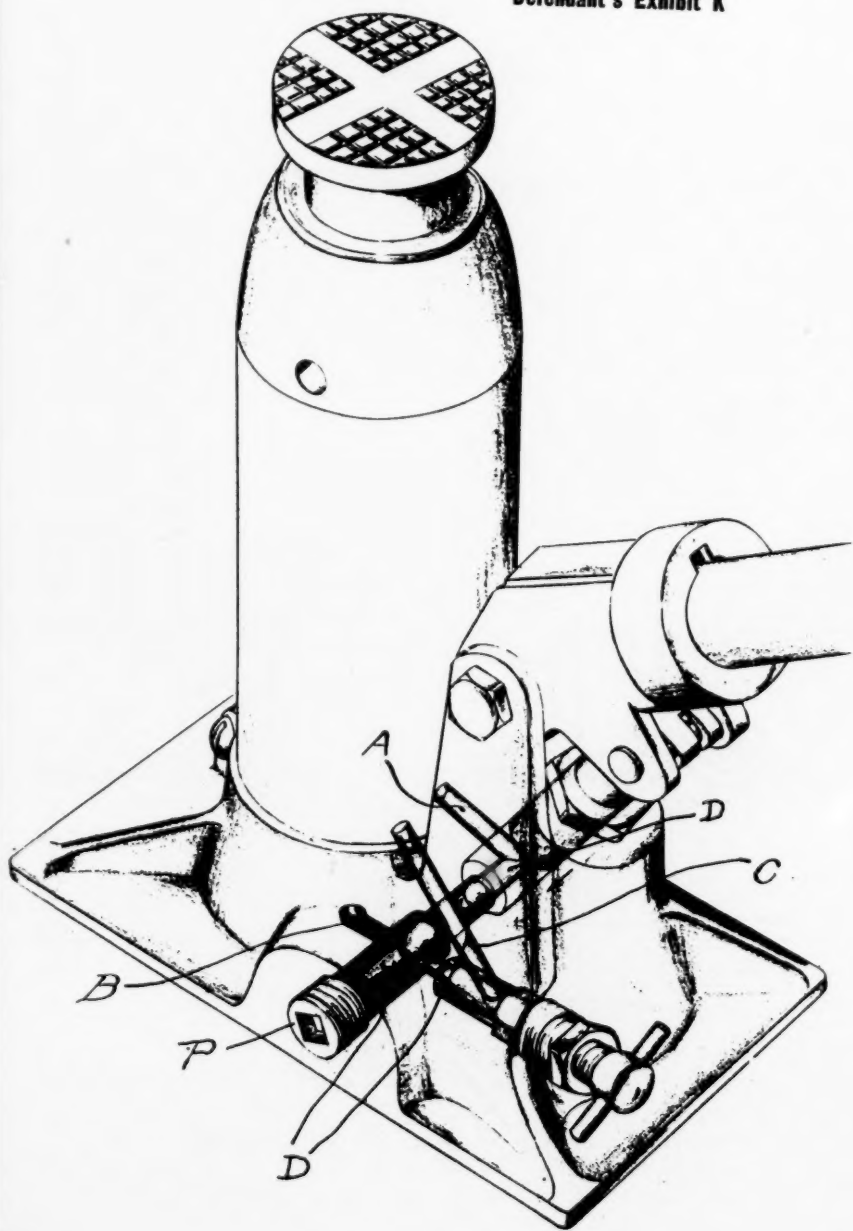
*Counsel for Respondent.*

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August 28, 1943.



# *DEFENDANT'S DEVICE*

Defendant's Exhibit K



# Defendant's Exhibit L

## DEFENDANT'S DEVICE

